

REMARKS

Claims 1-70 are pending in the application. In the Office Action of March 27, 2003, the Patent Examiner rejected claims 1-2, 16-19, 33, 35-36, 50, 52, 53 and 60-62 under 35 U.S.C. § 102(a) as being anticipated by article by Marc Gunther titled "The trouble with advertising" (hereinafter referred to as "Gunther"). In addition, the Patent Examiner rejected claims 3-15, 20-32, 34, 37-49, 51, 54-59 and 63-70 under 35 U.S.C. §103(a) as being unpatentable over Gunther.

In response, Applicants have traversed the Patent Examiner's rejections of the claims 1-70. Furthermore, the Applicants have canceled claims 17-18, 35 and 52-70 and have added new claims 71-81. No new matter is added by this Amendment.

Applicants thank the Patent Examiner for the courtesies extended by the Patent Examiner during her interview with Applicants' attorney on July 21, 2003.

Traversal of Rejections

Applicants respectfully traverse the Patent Examiner's rejections of claims 1-70. Moreover, the Applicants respectfully point out that the Sportsline program discussed in Gunther also is discussed in the AA reference entitled "Sportsline USA, Inc. Reports Fourth Quarter Financial Results" cited by the Patent Examiner in the Office Action dated March 8, 2002, and in the Sportsline related article entitled "CBS Sportsline Launches Innovative 'Sportsline Rewards' Relationship" Program dated January 19, 1999, cited in a Supplemental Information Disclosure Statement recently filed with the U.S. Patent and Trademark Office. The subject matter of all three articles were discussed by Applicants' attorney and the Patent Examiner during the interview on July 21, 2003. The three articles are hereinafter referred to collectively as the "Sportsline References".

As described in the Sportsline References, a user is given points for viewing a Web page in the Sportsline Web site. Thus, in the Sportsline system, the points are given to the user only after the Web page is provided to the user since the user cannot view the Web page until after the user receives the Web page. This is a major principle of operation of the Sportsline Web site and is a fundamental difference from Applicants' claimed invention.

In Applicants' claimed invention, a Web page is provided that includes hyperlinks, each of the hyperlinks having an associated point value (points also are referred to as "bones" in Applicants' disclosure, e.g., page 1, lines 32-34). This is another fundamental difference between the Applicants' invention and the Sportsline Web site, as the Sportsline Web site has no need or use for points associated with hyperlinks. In the Applicants' system, a user accessing the Web page is awarded points for selecting or otherwise clicking on a hyperlink since the hyperlink acts as a request for another Web page, service, feature, other Web site, advertisement, etc. that can be provided to the user. In contrast to the system disclosed in the Sportsline References, Applicants' claimed invention does not require or even need delivery to the user, receipt by the user, or viewing by the user of the Web page, other Web site, advertisement, etc. in order for the user to be awarded points. Rather, as described by the Applicants:

When a user selects a hyperlink, by for example clicking on it with his or her mouse, PC 1 sends a URL (uniform resource locator) corresponding to the hyperlink to webserver 3. In accordance with the present invention, a user is awarded points...for clicking on hyperlinks. The hyperlinks may represent, in the user's view, a request for a webpage or a portion of a webpage or a request for a service or other feature of a website.

Applicants' specification, page 3, lines 12-15. More specifically, as recited in Applicants' claim 71, a method of entering a user in a sweepstakes may include the following elements:

"providing a webpage for access by a user, the webpage including a plurality of hyperlinks, and each of the plurality of hyperlinks having an associated point value indicative of a number of at least one point the user can get for clicking on the hyperlink;" (See Applicants' disclosure, page 3, lines 7-12; page 5, lines 3-4; page 8, lines 16-17; Figures 3A and 3B)

"receiving a request, the request indicating that the user has clicked on one of the plurality of hyperlinks;" (See Applicants' disclosure, page 3, lines 12-17; page 6, lines 8-9)

“determining a point value associated with the one of the plurality of hyperlinks;”
(See Applicants’ disclosure, page 1, lines 34-35; page 6, lines 29 to page 7, line 2)

“awarding, based on the point value associated with the one of the plurality of hyperlinks, at least one point to the user as a result of the user clicking on the one of the plurality of hyperlinks; and” (See Applicants’ disclosure, page 1, lines 32-34; page 3, lines 14-15, 23-24)

“awarding, based on a number of at least one point awarded to the user for clicking the one of the plurality of hyperlinks, at least one entry in a sweepstakes.” (See Applicants’ disclosure, page 2, lines 3-5; page 3, lines 24-26; page 4, lines 35-36; page 8, lines 5-9)

Similar recitations are cited in Applicants independent claim 76 directed to a sweepstakes system and independent claim 81 directed to computer code.

As illustrated in the elements recited above, Applicants’ claimed invention includes associating points with hyperlinks displayed on a Web page such that a user can get points for clicking on the hyperlinks. In addition, after a user clicks on a specific hyperlink, a determination is made of how many points are associated with the hyperlink. In contrast, the Sportsline References do not disclose or even suggest an association of points with hyperlinks, determining a number of points associated with a hyperlink clicked on by a user, or awarding one or more points to a user based on the hyperlink clicked on by the user, as recited in Applicants’ independent claims 71, 76 and 81.

Having points associated with hyperlinks and determining how many points are associated with a specific hyperlink on a Web page in the Sportsline Web site as suggested by the Patent Examiner is completely unnecessary for operation of the Sportsline Web site and, in fact, would unduly complicate programming and operation of the Sportsline Web site for no reason or additional benefit. The Sportsline References teach directly away from the method, code and system recited in the Applicants’ independent claims and, as a result, the Sportsline References cannot suggest the modifications needed to implement the Applicants’ claimed invention. The mere fact that references can be combined or modified does not render the resultant combination or modification obvious unless the prior art also suggests the desirability

of the combination or modification, and even if a prior art system may be capable of being modified to run the way the Applicants' system is claimed, there must be some suggestion or motivation in the reference to do so. MPEP 2143.01 (citing In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)). The Sportsline References provide no such suggestion or motivation. Thus, Applicants' independent claims 71, 76, and 81 are novel and non-obvious over the Sportsline References, either alone or in combination.

In addition to the arguments above, since viewing, and hence receiving, a Web page to earn points is a specific intended requirement for the Sportsline Web site as described in the Sportsline References, the Sportsline web site cannot be modified to award points to a user merely for the user clicking on a hyperlink without destroying the intended function of the Sportsline Web site. It is not *prima facie* obvious to modify a reference so as to destroy its intended function. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In addition, modifying the Sportsline Web site to operate in the manner of Applicants' claimed invention would destroy the principle of operation of the Sportsline Web site as described in the Sportsline References, namely that points are awarded for viewing of Web pages. "If the proposed modification...of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims *prima facie* obvious." MPEP 2143.01 (citing In Re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)). Therefore, Applicants' independent claims 71, 76, and 81 are novel and non-obvious over the Sportsline References, either alone or in combination, for this reason as well.

All of the Applicants' dependent claims also are novel and non-obvious for the same reasons discussed above. In addition, the Sportsline References do not teach or even fairly suggest a system, method, or code where a point value associated with one or more hyperlinks is displayed on a Web page, as recited in Applicants' dependent claims 9, 10, 72, 73, 77, and 78. Since the Sportsline Web site does not associate points with hyperlinks, there would be no need to display points associated with hyperlinks on a Web page in proximity to the hyperlinks. Moreover, any display of such points on the Web page would decrease the area of the Web page available for other items or information for no reason or benefit, confuse a viewer of the Web page, and unnecessarily complicate coding of the Web page and operation of the Sportsline Web site. Thus, claims 9, 10, 72, 73, 77, and 78 are novel and non-obvious over the Sportsline References, either alone or in combination.

The Sportsline References also do not teach or even fairly suggest a system, code or method using a table to store information regarding the point value associated with one or more hyperlinks, as recited in Applicants' dependent claims 9, 14, 75, and 80. Since the Sportsline Web site does not associate points with hyperlinks, there would be no need for such a table and using such a table would unnecessarily complicate coding and operation of the Sportsline Web site for no reason or benefit. Thus, claims 9, 14, 75, and 80 are novel and non-obvious over the Sportsline References, either alone or in combination.

The Sportsline References also do not teach or even fairly suggest a system, code or method wherein a user is award on or more points associated with a hyperlink when clicking on the hyperlink and the hyperlink directs the user to a third-party website, as recited in Applicants' claims 16, 33, 50, 51, 74, and 79. Since the Sportsline program does not associate points with hyperlinks, there would be no need for such awarding points to a user for clicking on a hyperlink that directed the user away from the Sportsline Web site. Moreover, the Sportsline References only discuss awarding points for a user viewing pages on the Sportsline Web site. Rewarding the user for leaving the Sportsline Web site is contradictory to the program described in the Sportsline References. Thus, the Sportsline References teach directly away from the subject matter of claims 16, 33, 50, 51, 74, and 79 and claims 16, 74, and 79 are novel and non-obvious over the Sportsline References, either alone or in combination.

In regard to the Patent Examiner's specific rejections in the Office Action of claims 1-2, 16-19, 33, 35-36, 50, 52, 53 and 60-62 under 35 U.S.C. § 102(a) as being anticipated by Gunther, Applicants' respectfully point out that neither Gunther nor any of the Sportsline References disclose a Webpage having links or features wherein the links have an associated point value and/or wherein a user is awarded points for clicking on or selecting the links or features as recited in independent claims 1, 17, 35, 52, and 61 and included in their associated dependent claims. Thus, in contrast to the Patent Examiner's contention in the Office Action, all of the Applicants pending claims 1-70 are novel over the Gunther and the other Sportsline References. In addition, as previously discussed above, new independent claims 71, 76, and 81 also include similar recitations wherein links have associated point values and a user can get points for clicking on a link. Thus, all of the Applicants' new claims 71-81 are novel over all of the Sportsline References.

With regard to the Patent Examiner's specific rejections in the Office Action of claims 3-15, 20-32, 34, 37-49, 51, 54-59 and 63-70 under 35 U.S.C. § 103(a) as being unpatentable over Gunther, Applicants' disagree with all of the Patent Examiner's contentions.

With regard to the Patent Examiner's statements regarding claims 3, 13, 20, 30, 37, 47, 54, 57-59, 63 and 67, Applicants disagree with the Patent Examiner's assertions. Further, the mere fact that information may be stored in a database does not render it obvious to store user registration or point information as recited in these claims. Also, as it is improper to use Official Notice to comprise the principal evidence upon which a rejection is claimed, the Applicants request that the Patent Examiner provide evidence of such storage of user and point information as recited in these claims. See, MPEP 2144.03; In re Barr, 444 F.2d 588, 170 USPQ 330 (CCPA 1971).

With regard to the Patent Examiner's statements regarding claims 4-7, 9-12, 14-15, 21-24, 26-29, 31-32, 38-46, 48-49, 51, 55-56, 64-66 and 68-69, Applicants disagree with the Patent Examiner's assertions and note that the Patent Examiner has made only cursory statements without providing any supporting evidence as the basis of these rejections. Nor has the Patent Examiner provided any support for any motivation or suggestion in Gunther to make the modifications suggested by the Patent Examiner. Thus, the Patent Examiner has improperly rejected these claims. Moreover, the Patent Examiner appears to be using improperly the information in Applicants' claims as the basis for the rejections of these claims. Applicants request that the Patent Examiner clarify and provide support for the rejections to these claims independent of the Applicants' disclosure and claims.

With regard to the Patent Examiner's statements regarding claims 34 and 70 under the same rationale as the rejections of claims 16 and 33, the Applicants disagree with the Patent Examiner's contentions for the same reasons provided above in regard to claims 34 and 70.

With regard to the Patent Examiner's statements regarding claims 8 and 25, the Applicants agree with the Patent Examiner that Gunter does not teach that one of the services can be email. However, the Patent Examiner provides no support for the statement that email is a common service offered in the on-line world and provides no support or argument that there is any motivation or suggestion to provide such email service with the teachings of Gunther. As the Patent Examiner has not provided specific reasons to support the additional obviousness rejections, the Patent Examiner has failed to establish a prima facie case of obviousness for these

claims. Ex parte Humphries, 24 USPQ 1255, 1262 (BPAI 1992). Therefore, Applicants respectfully assert that the Patent Examiner has improperly rejected these claims.

Conclusion

In view of the foregoing, the application is believed to be in condition for allowance, and such action is respectfully requested at the Patent Examiner's earliest convenience. In this regard, it should be noted that Applicants' silence with respect to particular comments made in the Office Action (e.g., comments directed to various dependent claims) does not imply agreement with those comments.

If any issues remain, or if the Patent Examiner has any further suggestions for expediting allowance of the present application, the Patent Examiner is kindly invited to contact Scott B. Allison using the information provided below.

Respectfully submitted,



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Date

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